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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,340	06/27/2001	Robert A. Rousseau	ETH-1507	3554
27614	7590	01/27/2004		
RALPH W. SELITTO, JR. C/O MCCARTER & ENGLISH, LLP GATEWAY CENTER FOUR 100 MULBERRY STREET NEWARK, NJ 07102			EXAMINER LANDREM, KAMRIN R	
			ART UNIT 3738	PAPER NUMBER 12

DATE MAILED: 01/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/892,340

Applicant(s)

ROUSSEAU, ROBERT A.

Examiner

Kamrin R. Landrem

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/17/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

The affidavit filed on 11/17/03 under 37 CFR 1.131 is sufficient to overcome the Amid et al reference.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

*Cmm  
1/22/04*  
Claims 1, 3-6, 14, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Chaffrignon et al (USPN 5,919,232).

With reference to Figure 1, Chaffrignon discloses a prosthetic mesh system 1 adapted for implantation into an area containing a hernia defect (2:64) comprising a flexible biocompatible mesh 10 that has a generally flat shape (Figure 1) and a second generally collapsed shape (Figures 2 and 5). The mesh layer 10 has a plurality of ridges 5 formed integrally there within to facilitate movement of the mesh layer 10 from a flat to a generally collapsed configuration. The mesh layer is expandable from its collapsed shape to its flat shape after being implanted in the body (4:12-20).

With regards to Claim 2, this is considered a product by process claim. MPEP 2111 states, "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the

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prior product was made by a different process.” Chaffrignon does not specifically recite that a thermo-forming process forms the device however the product formed is the same and is therefore rejected in view of Chaffrignon. In addition the applicant’s specification, page 5, lines 18-21 disclose that other processes can be used for shaping the patch so as to provide ridges therein.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chaffrignon in view of Kugel (USPN 5,634,931).

Chaffrignon, as discussed above, discloses the prosthetic mesh system as claimed. Chaffrignon however does not disclose a mesh comprising two layers. With reference to Figure 5 Kugel teaches a hernia mesh patch (7:36-60) composed of a top 42 and a bottom layer 44 thus enabling the surgeon to place his or her finger between the layers and easily insert the patch (4:15-26). A ring 72 connects the layers 42,44. Therefore in view of the teachings it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the mesh system as disclosed by Chaffrignon to have two layers thus allowing the surgeon to easily insert the mesh with less tension, less post-operative discomfort, shorter operating time, and a lower potential cost to the patient (5:33-43).

Claims 9-13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Chaffrignon.

Chaffrignon discloses the prosthetic mesh as discussed above. Chaffrignon does not disclose expressly a mesh comprising ridges in multiple formations. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have formed the ridges into concentric circles or radial extensions from the center because Applicant has not disclosed that these ridge formations provide an advantage, are used for a particular purpose, or solve a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with ridges paralleling one another as taught by Chaffrignon because these ridges facilitate the movement of the mesh layer between a collapsed and a flat shape by pulling or releasing said ridges.

Therefore, it would have been an obvious matter of design choice to modify Chaffrignon to obtain the invention as specified in claims 9-13.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kamrin R. Landrem whose telephone number is 703-305-8061. The examiner can normally be reached on 8:00-5:00, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 703-308-2111. The fax phone number for the organization where this application or proceeding is assigned is 703-308-3905.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

Kamrin Landrem  
Examiner  
AU 3738

KRL-

  
**CORRINE McDERMOTT**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3700**